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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/289,000 | 02/25/1997 | GERALD BLATT | 16683-1-2 | 8112 |

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TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94105

EXAMINER

PREBILIC, PAUL B

| ART UNIT | PAPER NUMBER |
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3738

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/289,000

Applicant(s)

BLATT, GERALD

Examiner

Paul B. Prebilio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Upon careful review of the claims and the prior art of record, the Examiner discovered that the claims are not patentable thereover. This is due to his failure in the last Office action to compare the claims against all the prior art of record. The Office regrets any inconvenience that this may cause the Applicant.

Claim Objections

Claim 1 is objected to because of the following informalities:

On lines 6-7, the face of the implant "is adapted to face the cancellous bone surface", yet this same face is placed so that it "is opposite the cancellous bone surface"; see line 8. For this reason, the claim language is not clear since implant is not used in the manner suggested by the claim language and the disclosure. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Stone et al (US 5,306,311). Stone anticipates the claim language where removing the joint surface to expose cancellous bone is disclosed by Stone on column 5, line 58 to column 6, line 2 and on column 15, lines 35-50, the selecting implant step is disclosed by Stone on column 3, lines 3-10, the placing step is shown in Figure 9 and

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discussed on column 2, lines 49-61 (the cancellous bone is element (450)), the using step is explained in the previous citations of Stone, and the allowing step naturally occurs in the 3 to 6 months that the implant is in place; see Example 14 on column 15.

Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Cohen (US 5,207,712). Cohen anticipates the claim language where the removing step as claimed is met by the resection and/or hole drilling steps of Cohen (see column 4, lines 9-14), the forming a cavity step as claimed is met by the hole drilling of Cohen (see supra), and the selecting implant step is met by Cohen selecting the Type I implant which has a spherical face (see Figures 9 and 10 as well as column 3, lines 10-17). The face is freely slidable since flexion and extension can be performed on the joint after implantation (see column 4, lines 37-39). The using step as claimed is disclosed in Cohen (see supra), and the allowing step as claimed is disclosed by Cohen on column 2, lines 25-50, column 4, lines 33-36 and column 5, lines 29-32.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone et al (US 5,306,311) alone. Stone meets the claim language as explained in the Section 102 rejection, but fails to disclose estimating the time of healing and selecting an implant of the size, shape and material for that period of time. However, the

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Examiner asserts that it would have been obvious to perform these steps to an ordinary artisan in order to ensure the greatest success with the procedure.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone et al (US 5,306,311) in view of Athanasiou et al (US 5,607,474). Stone discloses using a wide variety of resorbable materials as the bioresorbable component, but fails to disclose using a lactic acid copolymer as claimed; see column 3, lines 39-46 and column 6, lines 18-55. However, Athanasiou teaches that it was known to make similar joint implants out of lactic acid copolymers; see Figures 2 and 3 as well as column 3, lines 35-59 and column 5, lines 24-45. Therefore, it is the Examiner position that it would have been prima facie obvious to replace some of the resorbable materials of Athanasiou with lactic acid copolymers in order to reduce the cost and antigenicity of the device as compared to using collagen.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul B. Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
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